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K&I, GATES LLP				
535 SMITHFIELD STREET				
PITTSBURGH, PA 15222				
EXAMINER				
BUL, LUAN KIM				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/699,271

## Applicant(s)

SU-SYIN, WU

## Examiner

Luan K. Bui

## Art Unit

3728

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13, 16-19 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 16-19 and 21-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Continued Prosecution Application***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/21/2008 has been entered.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 21, the phrase "the impermeable material" lacks proper antecedent basis.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 6-9, 17, 19 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Soto et al. (5,866,069; hereinafter Soto'069). Soto'069 discloses a sterilization package for enclosing a device such as medical products (column 1, lines 14-16 and column 4, lines 37-40)

during a sterilization procedure and storing the device in sterile form thereafter (column 1, line 66 to column 2, line 4), the package comprising a barrier film (column 2, lines 42-52 and column 3, lines 52-54) defining an interior space, the barrier film sealing the interior space from contaminating microorganisms and the barrier film formed from TYVEK which is considered equivalent to at least a portion of the barrier film formed of a semi-permeable material that permeable to sterilizing gasses (column 1, lines 66-67) and impermeable to contaminating microorganisms and at least a portion of an outer surface of the package is treated with silicone (column 3, lines 52-57) to render the package liquid repellent and able to withstand exposure to an oxidizing plasma sterilizing process. Since the outer surface of the package of Soto'069 is treated with silicone which is considered equivalent to the package having thereon a friction enhancing material (see claims 7 and 8 of the instant patent application) and the silicone can be applied by spraying to the outer surface of the package while not impeding permeation of sterilized gases (column 4, lines 37-47) which is considered equivalent to the friction enhancing material is applied in a pattern. The term "pattern" is broadly recited in the claimed read on the silicone disposed on the outer surface of the barrier film of Soto'069 since the silicone completely covers the outer surface of the barrier film.

As to claim 17, since the package of Soto'069 is made from the semi-permeable material, therefor, the friction enhancing material is applied on the semi-permeable material.

As to claim 22, see column 2, lines 18-19.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3-5, 16, 18, 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soto et al. (5,866,069; hereinafter Soto'069) in view of Hoekstra (6,986,730). Soto'069 discloses the sterilization package for enclosing the medical products as above having most of the claimed limitations except for the barrier film being formed of two separate film panels sealed together by a peripheral seal.

Hoekstra shows a pouch/sterilization package (100) for packaging medical devices comprising a first layer (20) formed from TYVEK which is a gas permeable microbial barrier defined as permeable to sterilizing gases and impermeable to microbial contaminants (column 3, lines 51-56), a second layer (30) formed from a transparent thermoplastic gas impermeable layer (column 6, lines 20-28) and the two layers sealed together by a peripheral seal. It would have been obvious to one having ordinary skill in the art at the time the invention was in view of Hoekstra to modify the barrier film of Soto'069 so the barrier comprises of two separate film panels sealed together by a peripheral seal because the selection of the specific method of packaging the device such as by wrapping or enclosing the device as taught by Soto'069 (column 4, lines 37-40) or as taught by Hekstra would have been an obvious matter of design choice inasmuch as the resultant structures will work equally well.

As to claim 21, Soto'069 discloses the sterilization package as above having most of the limitations of the claim except for the friction enhancing material being not impairing visibility of the device. Hekstra shows the second layer formed from the transparent material to allow the device (200) packaged within the pouch can be viewed (column 6, lines 27-28). It would have

been obvious to one having ordinary skill in the art in view of Hekstra to modify the package so the package is formed from a material that the friction enhancing material is not impairing visibility of the device to allow visual access to the device within the package.

8. Claims 1-13, 16-19 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoekstra (6,986,730) in view of Soto et al. (5m866m069; hereinafter Soto'069) and The European Publication No. 0 304 255 to Katila or The European Publication No. 0 863 087 to Hoeft or the German Patent No. 1 779 373 to Vollmer. Hoekstra discloses a sterilization package

Hoekstra discloses a pouch/sterilization package (100) for packaging medical devices comprising a first layer (20) formed from TYVEK which is a gas permeable microbial barrier defined as permeable to sterilizing gases and impermeable to microbial contaminants (column 3, lines 51-56) which is considered equivalent to at least a portion of the barrier film being formed of a semi-permeable material as claimed, a second layer (30) formed from a transparent thermoplastic gas impermeable layer such as a polycoated polyester, polycoated nylon, polyethylene (column 6, lines 20-28) and the two layers sealed together by a peripheral seal. Hekstra also discloses the other claimed limitations except for at least a portion of an outer surface of the package having a friction enhancing material thereon and the friction enhancing material is applied in a pattern while not impeding permeation of sterilizing gases.

Soto'069 shows the sterilization package as above having all the limitations as claimed includes at least a portion of an outer surface of the package having a friction enhancing material thereon and the friction enhancing material is applied in a pattern while not impeding permeation of

sterilizing gases. Katila teaches a package formed from a conventional foil (1) comprising a pattern of friction surface (2) disposed on an outer surface of the package to facilitate stacking of the packages (see abstract and column 1, lines 1-10). Hoeft shows a package comprising an outer surface and an anti-slip layer formed from a silicone based material disposed on the outer surface of the package to prevent the package slipping when the package is stacked with other packages (see abstract). Vollmer suggests a bag comprising an outer surface and anti-slip coating disposed on the outer surface of the bag to prevent slipping of the bags on storage or stacking.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made in view of Soto'069 and Katila or Hoeft or Vollmer to modify the sterilization package of Hekstra so it comprises at least a portion of an outer surface of the package having a friction enhancing material thereon and the friction enhancing material is applied in a pattern as taught by Katila or Hoeft or Vollmer while not impeding permeation of sterilizing gases to prevent the package from sliding when the package is disposed on a flat support surface.

#### ***Response to Arguments***

Applicant's arguments filed on 10/21/2008 have been fully considered but they are not deemed to be persuasive.

Applicant argues that Soto fails to teach a pattern as claimed on page 7 of the remarks is noted. This is not persuasive because the term "pattern" is broadly recited in the claimed read on the silicone disposed on the outer surface of the barrier film of Soto'069 since the silicone

completely covers the outer surface of the barrier film. The term pattern as claimed does not have to be a pattern as shown in Figure 2 of the instant patent application but it can be a layer of silicone disposed on the outer surface of the barrier film of Soto'069.

Applicant's arguments with respect to "a pattern" as claimed in the remarks are noted. They are not persuasive because applying friction enhancing material in a pattern can be considered as applying the friction enhancing material on the entire outer surface of the barrier film and the silicone covers the outer surface of the barrier film is the position that silicone applied in a pattern.

Applicant's arguments with respect to Katila or Hoeft or Vollmer on pages 11-14 of the remarks are noted. They are not persuasive because Katila or Hoeft or Vollmer is relied upon for nothing more than providing a package having a pattern of friction enhancing material disposed on an outer surface of the package to facilitate stacking of the packages.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is 571-272-4552. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

lkb  
November 6, 2008

/Luan K. Bui/  
Primary Examiner  
Art Unit 3728